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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,784	04/13/2001	Aprile L. Pilon	116142-00062	9471

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EXAMINER

ROMEO, DAVID S

ART UNIT PAPER NUMBER

1647

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

KL

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/835,784

Applicant(s)

PILON ET AL.

Examiner

David S. Romeo

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 27 May 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: See Continuation Sheet.

Claim(s) withdrawn from consideration: See Continuation Sheet.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____

David S. Romeo
David S. Romeo
Primary Examiner
Art Unit: 1647

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of Claims 129, 130, 132, 133, 138, 139, 215-218, 221, 222 under 35 U.S.C. 112, second paragraph, as being indefinite over the recitation of "derived from".

Continuation of 7. Claims rejected: 6, 7, 13, 14, 23, 24, 31, 32, 42, 43, 51, 60, 61, 69, 70, 78, 89, 90, 98, 107, 108, 116, 123, 124, 126, 127, 129, 130, 132, 133, 135, 136, 138, 139, 185, 186, 187, 188, 189, 190, 191, 192, 193, 194, 195, 197, 198, 199, 200, 201, 203, 204, 205, 207, 208, 209, 211, 212, 213, 214, 215, 216, 217, 218, 219, 220, 221, 222.

Claims withdrawn from consideration: 1-5, 8-12, 15-22, 25-30, 33-41, 44-50, 53-59, 62-69, 71-77, 80-88, 91-97, 100-106, 109-115, 118-122, 125, 128, 131, 134, 137, 140-184.

Continuation of 11. does NOT place the application in condition for allowance because: Claims 6, 7, 13, 14, 23, 24, 31, 32, 42, 43, 51, 60, 61, 69, 70, 78, 89, 90, 98, 107, 108, 116, 123, 124, 126, 127, 129, 130, 132, 133, 135, 136, 138, 139, 185-195, 197-201, 203-205, 207-209, 211-222 are rejected under 35 U.S.C. 102(a or b) as being anticipated by Zhang (U), as evidenced by Pilon (V), Cummins (A), and Singh (W).

Claims 6, 7, 13, 14, 23, 24, 31, 32, 42, 43, 51, 69, 70, 78, 89, 90, 98, 107, 108, 116, 123, 124, 126, 127, 135, 136, 185-195, 199-201, 203-205, 207-209, 211-214, 219, 220 are rejected under 35 U.S.C. 102(e) as being anticipated by Patierno (B), as evidenced by Singh (W).

Claims 129, 130, 132, 133, 138, 139, 215-218, 221, 222 rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang (U), as evidenced by Pilon (V), Cummins (A), and Singh (W).

Applicants argue that the examiner has not provided any specific reasons why the pending claims are not supported by the parent application. Applicant's arguments have been fully considered but they are not persuasive. The examiner is unable to find any disclosure of the literal language of the claims at the places indicated in the prior applications in the table filed with Applicants' response. Nor do Applicants indicate how the places indicated in the prior applications in the table filed with Applicants' response support the literal language of the claims.

Applicants argue that neither Zhang nor Patierno discloses a composition comprising UG in the amounts indicated in the claims. Applicant's arguments have been fully considered but they are not persuasive. Applicants' arguments are mere argument. Applicants have not presented any evidence that the amount of UG disclosed by either Zhang or Patierno is insufficient to achieve the intended effects. It is not necessary for either Zhang or Patierno to disclose any particular method or effect. As long as the prior art compositions comprise UG or UG/Fn in amounts sufficient to achieve the intended effects, then they anticipate the claims.

Applicants argue that neither Zhang nor Patierno describe the sequence of SEQ ID NO: 1. Applicant's arguments have been fully considered but they are not persuasive. Both Zhang and Patierno disclose human UG. Human UG consists essentially of the amino acid sequence of SEQ ID NO: 1, as evidenced by Singh.

Applicants' arguments regarding the dependent claims have been considered but they do not specifically point out how the language of the claims patentably distinguishes them from the references.

Claims 6-7, 13-14, 23-24, 31-32, 42-43, 51, 60-61, 69-70, 78, 89-90, 98, 107-108, 116, 123-124, 126-127, 129-130, 132-133, 135-136, and 138-139 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants argue that the rejection is without basis. Applicant's arguments have been fully considered but they are not persuasive. The test for definiteness under 35 U.S.C. 112, second paragraph, is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. The definition of "recombinant human uteroglobin" at page 17, full paragraph 1, is merely exemplary and is not intended to limit the definition of "recombinant human uteroglobin" in any way. Thus, a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.